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10/754,019	01/07/2004	Tetsuya Nakamura	2418.65US01	7101

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EXAMINER

ZACHARIA, RAMSEY E

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/754,019

Applicant(s)

NAKAMURA ET AL.

Examiner

Ramsey Zacharia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/7/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The phrase "the surface-side adhesion layer and the base-side adhesion layer are made of first resin and second resin" renders claim 2 indefinite because it is unclear if the two adhesion layers are both made from a blend of the first and second resin, or if one adhesion layer is made of the first resin and another adhesion layer is made of the second resin.

5. Claim 14 is renders indefinite because it is unclear if the surface-side and the base-side adhesion layers are intended to be molten layers or whether the adhesion layers are solid layers that were melted by heat during formation of the trimming material.

### ***Claim Language***

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6. For the purpose of examination, claim 2 is taken to mean that one of the surface-side or base-side adhesion layers is made of the first resin and another adhesion layer is made of the second resin. Moreover, claim 14 is taken to mean that the adhesive layers are solid layers that were melted by heat during the formation of the trimming material.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by FR 2,481,210 A.

Note: because a translation of FR 2,481,210 A was not available at the time of this action, the Derwent abstract of FR 2,481,210 A is attached.

FR 2,481,210 A teaches an adhesive placed between the decorative surface layer and support layer of a trimming material. The adhesive comprises a film having good thermobonding properties on both its surfaces and which does not creep at the forming temperature of the trimming. A suitable adhesive comprises a polyester barrier film with a polyurethane or epoxy resin coating applied on both surfaces.

The polyester barrier film corresponds to the barrier layer of instant claim 17, as a solid film it will be impermeable to liquid. That the adhesive has thermobonding properties on both its surfaces indicates that the surfaces (i.e. the polyurethane or epoxy resin) will melt during thermobonding. Furthermore, that the entire adhesive does not creep at the forming temperature

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indicates that the polyester core of the coating does not melt during the thermobonding. That is, each of the surface resins have melting points below that of the core polyester. Moreover, because the core and the surface layers are formed of different materials (i.e. polyester versus polyurethane or epoxy resin), the melt index of the core will be different than the melt index of the surface layers.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2,481,210 A.

FR 2,481,210 A teaches all the limitations of claim 18, as outlined above, except that the surface coatings of the polyester layer having different melt indexes. However, FR 2,481,210 A teaches that either polyurethane or epoxy resin may be used as surface materials.

That is, FR 2,481,210 A shows that polyurethane and epoxy resin are known in the art as functionally equivalent materials for coating the surface of the polyester film. Therefore, because these two materials were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to use polyurethane on one side of the polyester film and epoxy resin on the other side of the polyester resin. In so doing, the resulting coated polyester film would be coated with materials having melt indexes that are different from each other since the materials themselves would be different.

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11. Claims 1-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-278260 A in view of FR 2,481,210 A.

Note: because a translation of JP 6-278260 A was not available at the time of this action, the Derwent abstract of JP 6-278260 A is attached.

JP 6-278260 A teaches a laminate for a motor vehicle comprising a base sheet of resin felt, a skin sheet of a non-woven cloth or fabric, and a hot melt adhesive between the base sheet and skin film. The adhesive layer is colored to have the same color as that of the skin sheet or a difference in lightness between the skin of  $\pm 5$ .

JP 6-278260 A does not teach that their colored adhesive layer comprises three layers as claimed.

FR 2,481,210 A teaches an adhesive film for bonding the decorative layer and felt support layer of a trimming material. The adhesive film has good thermobonding properties on both its surfaces and does not creep at the forming temperature of the trimming. A suitable adhesive film comprises a polyester barrier film with a polyurethane or epoxy resin applied on both surfaces. The adhesive film prevents the migration to the decorative layer of resin binder used for consolidating the felt support.

The polyester barrier film corresponds to the barrier layer of instant claims, as a solid film it will be impermeable to liquid. That the coating has thermobonding properties on both its surfaces indicates that the surfaces (i.e. the polyurethane or epoxy resin) will melt during thermobonding. Furthermore, that the entire coating does not creep at the forming temperature indicates that the polyester core of the coating does not melt during the thermobonding. That is,

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each of the surface resins have melting points below that of the core polyester. Moreover, because the core and the surface layers are formed of different materials (i.e. polyester versus polyurethane or epoxy resin), the melt index of the core will be different than the melt index of the surface layers.

One skilled in the art would be motivated to use the adhesive film of FR 2,481,210 A in the laminate of JP 6-278260 A to prevent migration of binder from the felt base sheet to the skin sheet. Because both the skin sheet and base sheet of JP 6-278260 A may be made of fabric or felt, there will be at least some permeation of the polyurethane/epoxy resin material during the bonding process.

Regarding claims 2 and 18, FR 2,481,210 A shows that polyurethane and epoxy resin are known in the art as functionally equivalent materials for coating the surface of the polyester film. Therefore, because these two materials were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to use polyurethane on one side of the polyester film and epoxy resin on the other side of the polyester resin. In so doing, the resulting coated polyester film would be coated with materials having melt indexes and flowabilities that are different from each other since the materials themselves would be different.

Regarding the color limitations (particularly claims 2, 3, 5, and 11-13), JP 6-278260 A explicitly teach that the adhesive layer should have a color that is the same or similar in lightness to that of the skin layer. Because a polyester film as well as polyurethane and epoxy coatings can all be loaded with colorants, it would be obvious to one skilled in the art to add colorants to one or more of the layers that comprise the adhesive film of FR 2,481,210 A such that the

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resulting film has an overall appearance that is the same color or similar lightness to that of the skin layer.

*Allowable Subject Matter*

12. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter.

In addition to all the limitations of claims 7, 14, and 15, claim 16 further requires a first mutual adhesion layer between the surface-side adhesion layer and the barrier layer and a second mutual adhesion layers interposed between the base-side adhesion layer and the barrier layer. The first and second mutual adhesion layers are each made of a resin having a melting point lower than the melting point of the barrier layer.

FR 2,481,210 A represents the closest prior art. From the Derwent abstract, FR 2,481,210 A does not teach or fairly suggest the addition of adhesion layers between the polyester film and the polyurethane/epoxy resin surface layers. However, it should be noted that this conclusion is based only on the summary provided by the Derwent abstract and it is possible that the indication of allowable subject matter may be withdrawn upon receipt of a complete English translation of FR 2,481,210 A.



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***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518.

The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ramsey Zacharia  
Primary Examiner  
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